



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/401,004 | 09/21/1999 | HENGYUAN LANG | P-HP-3589 | 4060 |

7590 02/12/2004
LAW OFFICE OF DAVID SPOLTER
1590 COAST WALK
LA JOLLA, CA 92037

EXAMINER

EPPERSON, JON D

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1639

DATE MAILED: 02/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|------------------------------------|--|
| Office Action Summary | Application No. 09/401,004 | Applicant(s) LANG ET AL. | |
| | Examiner Jon D Epperson | Art Unit 1639 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-36 and 38-48 is/are pending in the application.
- 4a) Of the above claim(s) 23,24,27-34,41 and 46-48 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17,19-21,26,35,36,39,40,42 and 44 is/are rejected.
- 7) ☐ Claim(s) 18,22,25,38,43 and 45 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Please note: There is a change in Examiner handling prosecution in this case from Maurie Baker to Jon Epperson.

Request for Continued Examination (RCE)

1. A request for continued examination (RCE) under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/10/03 has been entered. Claims 17-36 and 38-48 are pending. Claims 23-24, 27-34, 41 and 46-48 are drawn to non-elected species and/or inventions (see Paper No. 27) and thus these claims remain withdrawn from further consideration by the examiner, 37 CFR 1.142(b), there being no allowable generic claim. Therefore, claims 17-22, 25-26, 35-36, 38-40 and 42-45 are examined on the merits in this action.

Those sections of Title 35, US code, not included in the instant action can be found in previous office actions.

Withdrawn Objections/Rejections

2. All previous objections and/or rejections are withdrawn in view of Applicants' amendments and/or arguments.

New Objections and/or Rejections

Objections to the Claims

3. Claims 17-22, 25-26, 35, 38, 43 and 45 are objected to because of the following informalities:

- A. Claims 18, 22, 25, 38, 43 and 45 are objected to as being dependent upon a rejected base claim.
- B. Claims 17-22, 25-26 and 35 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form or rewrite the claim(s) in independent form. For example, claims 17-22, 25, 35 depend from a “later” claim (i.e., claims 36 or 39), not a “previous” claim.

Claims Rejections - 35 U.S.C. 112, second paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 26 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 1639

A. For **claim 26**, it is not clear what the R groups refer to because the base claim (i.e., claim 16) has been canceled. Applicants are requested to correct. Therefore, claim 26 and all dependent claims are rejected under 35 U.S.C. 112, second paragraph.

Claims Rejections - 35 U.S.C. 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 17, 20, 35, 39-40, 44 are rejected under 35 U.S.C. 102(b) as being anticipated by Hideg et al (Hideg, K.; Hankovszky, H.O. "Benzazoles. III. Alkylation of benzimidazoles" Acta Chirurgica Academiae Scientiarum Hungaricae (1966), 49(3), 303-10).

For *claims 17, 20, 35, 39-40, 44*, Hideg et al (see entire document) discloses N,N-diethyl-2-phenyl-1-benzimidazoleacetamide (see Hideg et al, abstract; see also attached sheet with registry number 14521-64-3P; see also Table III, 25), which anticipates claim 1. This compound reads on the instant claims when R¹-R⁴ are hydrogen; R⁵ is phenyl; R⁶ is methylene; R⁷ and R⁸ are ethyl groups (i.e., falls within the scope of C¹ to C¹² alkyl).

6. Claims 17, 20-21, 35, 39-40, 44 are rejected under 35 U.S.C. 102(b) as being anticipated by Sawlewicz et al (Sawlewicz, J.; Milczarska, B. "Reactions of cyanomethylbenzimidazoles. I.

Art Unit: 1639

Synthesis of 1- and 2-cyanomethylbenzimidazoles and some of their derivatives” Polish Journal of Pharmacology and Pharmacy (1974), 26(6), 639-46).

For *claims 17, 20-21, 35, 39-40, 44*, Sawlewicz et al (see entire document) disclose 2-phenyl-1-benzimidazole-1-acetamide (see Sawlewicz et al, abstract; see also attached sheet with registry number 54980-93-7P; see also Table 2, compound XXII), which anticipates claim 1. This compound reads on the instant claims when R¹-R⁴ are hydrogen; R⁵ is phenyl; R⁶ is methylene; R⁷ and R⁸ are both hydrogen.

7. Claims 19, 21, 35-36, 39 and 42 are rejected under 35 U.S.C. 102(b) as being anticipated by Barton et al (EP 448206) (Date of Patent is 1992).

For *claims 19, 21, 35-36, 39 and 42*, Barton et al (see entire document) disclose 5-[2-chloro-6-fluoro-4-(trifluoromethyl)phenoxy]-2-(trifluoromethyl)-1-Benzimidazole-1-acetamide (see Barton et al, abstract; see also attached sheet with registry number 138031-97-7P; Table 4, compound 73), which anticipates claim 1. This compound reads on the instant claims when R¹, R² and R⁴ are hydrogen; R³ is a protected hydroxyl (i.e., the tri-substituted phenyl ring is the protecting group); R⁵ is a substituted C-1 alkyl (i.e., the -CF₃); R⁶ is methylene; R⁷ and R⁸ are both hydrogen.

Art Unit: 1639

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jon D Epperson whose telephone number is (703) 308-2423. The examiner can normally be reached Monday-Friday from 8:30 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on (703) 306-3217. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

Jon D. Epperson, Ph.D.

January 28, 2003

RECEIVED
FEB 11 2003

